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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,220	08/13/2001	Brian Minear	010240	2135

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Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

EXAMINER

HAQ, NAEEM U

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,220

Applicant(s)

MINEAR ET AL.

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to the Applicants' amendment A, paper number 6, filed on June 13, 2003. Claims 1-25 are pending and will be considered for examination.

Final Rejection

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Javed (US PGPUB 2001/0036271 A1) in view of Munyan (US Patent 5,761,485) in view of Applicants' admission of prior art.

Referring to claims 1, 4-7, 11, 12, 15-19, 20, and 25, Javed teaches a system for providing downloadable subscription-based software to one or more wireless devices, comprising:

- one or more wireless devices, each wireless device in selective communication with a wireless network and selectively downloading one or more subscription-based software applications to be executable on the wireless device, (page 1, section [0015]; page 2, section [0016]; page 3, section [0045]; page 7, section [0077]);
- one or more application download servers, each application download server selectively communicating with the one or more wireless devices across the wireless network and downloading to the wireless devices at

least one subscription-based software application, each application download server generating subscription-based application download data for each subscription-based software application downloaded by a wireless device therefrom (page 3, sections [0042], [0043]; page 4, section [0049], [0050]);

- an accounting module to account for the use of subscription-based software applications by each wireless device, the accounting module receiving subscription-based application download data from the one or more application download servers and subscription-based application deletion data from each wireless device (page 4, section [0050], [0052]).

Javed does not teach deleting a subscription-based application from a wireless device. However, Munyan teaches deleting a subscription-based application from a wireless device (column 8, lines 58-65). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Munyan into the system of Javed. One of ordinary skill in the art would have been motivated to do so in order to allow a user to make room for more selections to be downloaded, as taught by Munyan (column 8, lines 58-60). Javed and Munyan do not teach that the accounting is based upon the combination of the subscription-based software application download data and the subscription-based application deletion data. However this limitation is rendered obvious over Javed and Munyan. Both Javed and Munyan teach downloading subscription-based services over a wireless network. Furthermore, Javed teaches that the subscription-based service can be rented, and

Munyan teaches that the subscription-based service can be deleted from the wireless device. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow a user to notify the VISP or the VPOP (i.e. application server) that the rental period was over by transmitting deletion data to the server. One of ordinary skill in the art would have been motivated to do so in order to stop charging a user for an expired rental subscription. Javed and Munyan do not teach that the wireless device is configured to transmit voice communication from a user to the wireless network. However, the Applicants admit that it is well known in the art for a wireless device to communicate voice over a wireless network (page 1, lines 9-10). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate voice communication into the system and method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to allow a user to carry out oral communication using the wireless device.

Referring to claims 2, 3, 13, 14, and 21-24, Javed teaches that the accounting module is resident on the application download server from which a subscription-based software application was downloaded (Figure 2, items "224" and "234"; page 3, section [0046]).

Referring to claims 8-10, Javed and Munyan do not explicitly teach that the device is a cellular telephone, PDA, or pager. However, these devices are old and notoriously well known in the art. Furthermore, Javed teaches that his system maybe implemented on other architectures that do not depart from the spirit and scope of the invention (page 3, section [0045]). Therefore it would have been obvious to one of ordinary skill in the art,

at the time the invention was made, to implement the system of Javed and Munyan on a cellular telephone, PDA, or pager. One of ordinary skill in the art would have been motivated to do so in order to implement the system of Javed and Munyan on devices that are well known and commercially successful.

Response to Arguments

Applicants' arguments/amendment filed June 13, 2003 with respect to the 112 rejection of the previous Office Action have been fully considered and are persuasive. Therefore the 112 rejection is hereby withdrawn.

Applicant's arguments filed June 13, 2003 with respect to the 103 rejection have been fully considered but they are not persuasive. The Applicants have argued that the cited prior art teaches downloading "content" and not "applications". The Examiner respectfully disagrees. The Applicants' specification teaches that an "application" can be "...games, printed media, stock updates, news, *or any other type of information or program available for download through the wireless network.*" (emphasis added; page 1, lines 18-23). The Examiner notes that Javed's "content" is a program available for download through a wireless network. For this reason, the Examiner maintains the art rejection.

Conclusion

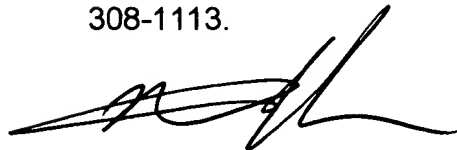
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

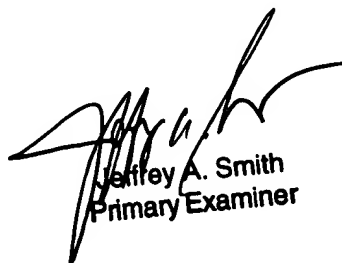
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner
Art Unit 3625

October 6, 2003



Jeffrey A. Smith
Primary Examiner